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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,004	04/08/2004	Thomas P. Adams	1827.030	9306
23598 7590 10/29/2008 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER SHAPIRO, JEFFERY A				
ART UNIT 3653		PAPER NUMBER		
NOTIFICATION DATE 10/20/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/821,004

Applicant(s)

ADAMS ET AL.

Examiner

JEFFREY A. SHAPIRO

Art Unit

3653

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 7/28/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/08 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-9, 12-21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,318,537 B1) in view of Harris (US 5,067,928) and further in view of Sasadi (US 4,125,195).

Regarding Claims 1, 18 and 26, Jones discloses a coin recycling machine (10) having a housing, as illustrated in figures 1 and 2, an intake area (14), a sorting mechanism (32, 250), as illustrated in figures 2, 20 and 21 and discussed at col. 18, lines 50-67, a plurality of dispensing hoppers (402a-f), as illustrated at figures 20, 21 and discussed at col. 18, line 50-col. 19, line 25, coin transfer mechanisms (256, 258a-d) and 260-265), as discussed at col. 20, lines 3-18 and col. 14, lines 25-67, a controller (39), that calculates first totals from the intake area through coin processor (32) and second totals for coins being dispensed via coin counters (404a-f). See also col. 19, lines 20 and 21, which states that the values for coins transported to an operator are calculated.

Regarding Claims 1 and 26, Jones does not expressly disclose, but Harris discloses using a bulk coin receptacle, (70), to fill a dispensing hopper (56) when a low condition is sensed in the primary hopper, for the purpose of increasing the capacity of the machine, thereby reducing the need to replenish the machine and the cost of labor as well as reducing machine downtime. See Harris at col. 1, line 61-col. 2, line 35, which describes the problem of dispensing hopper depletion which causes machine downtime. Note also that Harris discloses at col. 3, lines 10-33 that a set of sensors detect the levels of both the bulk coin receptacle and the dispensing hopper.

Such frequent refilling requires extra labor than a machine which reduces refilling. Note also that Jones mentions at col. 18, lines 23-49 an intent to reduce such downtime.

Further regarding Claims 2, 8, 9, 16, 21, Harris discloses a transfer mechanism comprising a platform (90), which lifts coins from the bottom of the bulk coin receptacle (70) towards the top opening (78a, b), where coins at the top of the column of coins are "skimmed" off the top by "skimmer" (116) which transports the coins to the dispensing hopper from the bulk coin storage receptacle by pushing them through opening (78a, b), as illustrated in figures 5-6 of Harris and discussed at col. 3, lines 10-33 and col. 9, line 56-col. 10, line 3.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a bulk coin receptacle and associated transfer mechanism to each of Jones' dispensing hoppers (402a-f), as taught by Harris, for the purpose of increasing coin storage capacity, thereby reducing machine downtime and labor associated with servicing the coin machine.

Further regarding Claims 1, 18 and 26, although Jones does not expressly disclose comparing the first and second totals, it would have been obvious to one of ordinary skill to perform this step as Jones' system discloses collecting such data and therefore making it "available" to a user, as called for in the last two lines of Claim 1, for the purpose of accounting for coins processed by Jones' apparatus. Therefore, it would have been obvious for one ordinarily skilled in the art to have performed the method steps of Claims 18 and 26 using Jones' apparatus.

Regarding Claims 1 and 18, Jones does not expressly disclose but Sasadi discloses automatically moving the dispensing spouts by use of solenoid valves and linkages, as depicted in figures 6 and 13 of Sasadi, for the purpose of pivoting the dispensing spouts so as to fit differing containers, i.e., "a variety of cars". See Abstract of Sasadi.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated solenoid valves and linkages for the purpose of moving the dispensing spouts of Jones to fit various configurations of coin containers. See Sasadi, cited previously.

Regarding Claim 3, Jones also discloses that the controller (39) has a plurality of control circuits that controls transfer of coins from each coin receptacle station (40). See col. 7, lines 8-22 and 34-48.

Note that it would have further been obvious to cause each control circuit for each receptacle station to control the transfer of coins between the dispensing hopper and the bulk storage receptacles.

Regarding Claims 4 and 5, note that it would have been obvious to make the bulk coin storage receptacles of any particular capacity size ratio with respect to the dispensing hoppers based upon the requirements of the operator's business. See col. 15, lines 33-41 of Jones.

Regarding Claims 6, 19 and 27, Jones states that both coin input valuation and coin output valuation can be performed at the same time. See Jones at col. 19, lines 7-25.

Regarding Claims 7 and 20, Jones discloses at figure 3, for example, coin diverters (44, 46a and 46b) located near exits leading to either coin bags (52) or coin receptacles (54, 56). It therefore would have been obvious to divert coins from the bulk coin receptacles to either the dispensing hoppers or to the coin bags directly, according to the volume requirements of the operator's business. See again, Jones at col. 19, lines 7-25. One ordinarily skilled would have found it obvious to divert coins from the bulk coin receptacles rather than the dispensing hoppers so as to not disturb the dispensing hoppers, which service users. Therefore, the bulk coin receptacles would act as a buffer

Regarding Claims 12, 13, 23 and 24, Jones discloses a media reader device (24) that can read an identification card or a smart card and has various memory storage, as discussed at col. 5, lines 25-37. Col. 1, lines 20-27, col. 2, lines 10-24 and col. 5, lines 23 and 24 disclose that Jones' machine can credit a user's account. As Jones also discloses at col. 19, lines 20-21, that value totals are maintained, it is considered to be obvious to one of ordinary skill in the art to have connected the system controller (39) to a memory that stores the various user accounts, input and output values for plural users, as this is a standard method for storing and manipulating the data discussed by Jones.

Regarding Claims 14 and 25, Jones discloses a touch screen at (12) at col. 4, lines 45-51 and col. 5, lines 28-33.

Regarding Claim 15, although Jones does not expressly disclose use of a personal computer or microprocessor, it is considered to be obvious to one of ordinary

skill in the art to install such a controller in the form of either a computer or a microprocessor in order to process the data and controls described by Jones, since only a solid-state computer, microprocessor or the equivalent would efficiently process such data and control instructions as described by Jones. Note also that such a solid-state microprocessor or computer is a small, compact control device that preserves space for other components.

Regarding Claims 17, note that the term "denomination sensor" is interpreted as being a sensor that counts coins. Jones' discloses counting sensors (404a-f), as described at col. 19, lines 10-21. See also Jones at col. 19, lines 40-55. Regarding personal accounts, again note Jones at col. 1, lines 20-27, col. 2, lines 10-24 and col. 5, lines 23 and 24 which discloses that Jones' machine can credit a user's account. Again, note that col. 19, lines 20-21 describes maintaining value totals.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,318,537 B1) in view of Harris (US 5,067,928) and further in view of Petri (US 5,830,054).

Jones discloses the system described above. Note again that Jones at col. 6, line 61-col. 7, line 7 discloses using various coin receptacles. Figure 3 of Jones illustrates coin bags and coin boxes being used.

Jones does not expressly disclose, but Petri discloses cash drawer at figure 3 and col. 5, lines 8-17.

At the time of the invention, one ordinarily skilled in the art would have found it obvious to fill a cash drawer as a coin receptacle, as taught by Petri, with Jones' coin

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dispensing device in light of Petri's teaching of filling cash drawers and Jones' teaching of filling various coin receptacles with his coin dispensing system.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9, 11-21 and 23-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-18 of U.S. Patent No. 6,983,836 in view of Harris U.S. Patent No. 5,067,928.

Adams discloses a cash input area, a sorting mechanism, plural receptacles, plural denomination sensors, and a controller. See Adams, Claim 1, for example.

Adams does not expressly disclose, but Harris discloses using a bulk coin receptacle, (70), to fill a dispensing hopper (56) when a low condition is sensed in the primary hopper, for the purpose of increasing the capacity of the machine, thereby

reducing the need to replenish the machine and the cost of labor as well as reducing machine downtime. See Harris at col. 1, line 61-col. 2, line 35, which describes the problem of dispensing hopper depletion which causes machine downtime. Note also that Harris discloses at col. 3, lines 10-33 that a set of sensors detect the levels of both the bulk coin receptacle and the dispensing hopper.

Such frequent refilling requires extra labor than a machine which reduces refilling.

Further regarding Claims 2, 8, 9, 16 and 21, Harris discloses a transfer mechanism comprising a platform (90), which lifts coins from the bottom of the bulk coin receptacle (70) towards the top opening (78a, b), where coins at the top of the column of coins are "skimmed" off the top by "skimmer" (116) which transports the coins to the dispensing hopper from the bulk coin storage receptacle by pushing them through opening (78a, b), as illustrated in figures 5-6 of Harris and discussed at col. 3, lines 10-33 and col. 9, line 56-col. 10, line 3.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a bulk coin receptacle and associated transfer mechanism to each of Adams' dispensing hoppers (402a-f), as taught by Harris, for the purpose of increasing coin storage capacity, thereby reducing machine downtime and labor associated with servicing the coin machine.

Response to Arguments

8. Applicant's arguments filed 7/28/08 have been fully considered but they are not persuasive.

I. DOUBLE PATENTING REJECTION

With regards to the double patenting rejection delineated above, as Applicant points out, the patent terms between the instant application and the '836 patent is not different and both have common ownership. However, this ownership may not remain the same over the entire term of the patents and patent term adjustments may make the patent terms different. Therefore, the double patenting rejection over the instant application has been maintained.

II. REPLY TO APPLICANT'S ARGUMENTS CONCERNING REJECTIONS UNDER 35 U.S.C. 103 (a).

The recent decision rendered in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See recent Board decision *Ex Parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Sasadi, cited above, discloses a system of dispensing outlets that are moved automatically by solenoid valves and mechanical linkages.

As described above, it would have been obvious to combine Jones with Sasadi in order to accommodate varying configurations of coin compartments.

Applicant appears to assert that Harris cannot be combined with Jones because Harris is non-analogous art since it is disclosed as being used in a vending machine. Nonetheless, Harris is being used for the teaching of increasing capacity of holding coins, of which Jones' apparatus, which processes and stores coins, will require depending upon the application and throughput required. It would therefore have been obvious to combine Harris with Jones since Harris discloses solving a problem, i.e., the problem of increasing capacity of coins handled, that one ordinarily skilled in the art would have recognized as being a problem in Jones' apparatus.

Regarding Applicants' arguments concerning Petri, note that Petri is only used for the teaching of using cash drawers in Jones' apparatus. With the use of Sasadi's teaching, no manual manipulation of containers is required. Also, Jones does not disclose manual manipulation of coin receptacles.

Regarding dispensing on a per user basis and allowing users to control the machine as an operator, who is the operator and who is a user is relative. Note that the operator can be construed to be a user, and even if the operator and user is construed as different, an operator can also be a user. Note also that nothing precludes the same person from both withdrawing and depositing cash.

Regarding Claims 18 and 26, comparison of coinage received in the second operating cycle with the amount of coinage dispensed in the first operating cycle so as to determine a net amount of coinage associated with a user account is considered

common business practice that one ordinarily skilled in the art would have found obvious to include in Jones' machine, especially in light of col. 18, line 65, since processing coins necessarily requires accounting for coins processed.

Further regarding Sasadi, it would have been obvious to one of ordinary skill to direct material, i.e., coins, to various compartments in light of Sasadi's disclosure of multiple piping ports and Jones' teaching of multiple coin storage receptacles for the purpose of increasing capacity and efficiency of Jones' device.

With regards to Jones' bulk coin receptacles (402), Jones, Harris and Sasadi all teach in combination Applicant's claimed apparatus.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant asserts that Harris does not explain how coins are sorted into multiple denominations. However, Harris is not used for this aspect, which Jones discloses and teaches. Harris teaches an elevator unit, and is used for this teaching in combination with Jones and Sasadi. Note also that one ordinarily skilled would have found it obvious and logical to duplicate Harris' elevator unit in any of the paths incorporating the bulk storage devices of Jones, since Harris' elevator unit provides a buffer of inventory to fill said storage devices for subsequent dispensing of coins.

Regarding Petri, the fact that no elevator type receptacles are provided are immaterial since Petri is used only for its teaching that cash drawers are commonly used cash receptacles and thus it would have been obvious to cause Jones' apparatus to accommodate such receptacles.

Also note that with regards to Claim 1, under MPEP 2115, apparatus claims are not distinguished with regards to patentability by the item worked on, i.e., in this case, the cash or coins processed or the tray filled. Also, under MPEP 2114, functional or intended use language does not distinguish apparatus claims with regards to patentability.

Thus the added language "dispensing coins to the individual receptacle" does not distinguish Claim 1 since it is both intended use, i.e., "for receiving and holding...", and the receptacle is the item the apparatus works on.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/
Primary Examiner, Art Unit 3653

October 14, 2008